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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,537	03/10/2004	Chin-Yao Chang	YTNP0001USA	2536
27765 7590 10/31/2007 NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116			EXAMINER MARANDI, JAMES R	
			ART UNIT 2609	PAPER NUMBER
			NOTIFICATION DATE 10/31/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Patent.admin.uspto.Rcv@naipo.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/708,537	<b>Applicant(s)</b> CHANG, CHIN-YAO	
	<b>Examiner</b> James R. Marandi	<b>Art Unit</b> 4157	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1- 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: Multimedia Disk Holder with a Chip.

### *Claim Rejections - 35 USC § 101*

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 14 through 26 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 through 15 of copending Application No. 10/708,537.

Multimedia disk, Compact Disk (CD), and Digital Video Disk (DVD) are known to have similar physical characteristics, as such what applies to one, in particular a box holding them, should be the same.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Mark Brent Hodes US Patent Application Publication 2003/0019770 (hereinafter "Hodes").

Regarding claim 1, Hodes discloses the following as claimed:

A multimedia disk box (figs. 1-2 or 11, [0005]) comprising: a housing, comprising a recess for holding at least a multimedia disk (figs. 1-2); and a chip in the multimedia disk box for storing and outputting a signal ([0058-0059]).

Claim 2: The multimedia disk box of claim 1 wherein the housing further comprises a cover for covering the recess. (Rejected as applied to claim 1. Again, see fig. 1 or 11).

Claim 3: The multimedia disk box of claim 1 wherein the chip is embedded in the housing. (Rejected as applied to claim 1. Again, see fig. 1 or 11).

Claim 4: The multimedia disk box of claim 1 wherein the chip comprises: a storage unit for storing the signal; and an output device electrically connected with the storage unit

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for outputting the signal stored in the storage unit. (See [0060] i.e., smart card or hard drive card, which can be read/write (input/output) as understood and expected in the art).

Claim 5: The multimedia disk box of claim 4 wherein the storage unit comprises a Read Only Memory (ROM), an Erasable Programmable ROM (EPROM), an Electrically Erasable Programmable ROM (EEPROM), or a Flash ROM. (Rejected as applied to claim 4. Furthermore, smart card or hard drive card fits the definition of one of the enumerated memories as claimed).

Claim 6: The multimedia disk box of claim 4 wherein the signal comprises multimedia, digital data, passwords of encryption/decryption, or programs. (See [0060] i.e., encoded data fit one of the enumerated types as claimed).

Claim 7: The multimedia disk box of claim 4 wherein the output device is a signal port for outputting the signal serially. (See [0005] i.e., communications via DSL).

Claim 8: The multimedia disk box of claim 4 wherein the output device is a player for playing the signal. (See [0005], i.e., computer chip).

Claim 9: The multimedia disk box of claim 4 wherein the chip further comprises a power supply for providing power required by the chip. (Rejected as applied to claims 1 and 4.

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Power supply would have been inherent and expected in Hodes).

Claim 10: The multimedia disk box of claim 9 wherein the power supply comprises a power converter for converting a power into a specified power required by the chip.

(Rejected as applied to claims 1, 4, 9. Power conversion would have been inherent and expect for computer chip operation in Hodes).

Claim 11: The multimedia disk box of claim 9 wherein the chip further comprises an input device electrically connected to the power supply and the storage unit for receiving a signal sent to the chip. (Rejected as applied to claims 1 and 4. An input signal line would have been inherent and expected to the operation of a computer chip in Hodes).

Claim 12: The multimedia disk box of claim 11 wherein the housing further comprises an input control switch electrically connected to the input device for controlling the signal to input. (Rejected as applied to claims 1, 4, 11. An input control switch for an input signal line would have been inherent and expected to the operation of a computer chip in Hodes).

Claim 13: The multimedia disk box of claim 12 wherein the chip further comprises a control unit electrically connected to the power supply, the input device, and the output device for controlling the functions of the chip, the control unit transmitting an input instruction to the input device to receive and store the signal, the control unit

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transmitting an output instruction to the output device to output the stored signal.

(Rejected as applied to claims 1, 4, 11 and 12).

Claim 14: The multimedia disk box of claim 1 wherein the multimedia disk is a Compact Disk (CD). (See [0005]).

Claim 15: The multimedia disk box of claim 1 wherein the multimedia disk is a Digital Video Disk (DVD). (See [0005]).

Claims 16-26 are rejected as applied to claims 1-15.

### ***Conclusion***

Attaching intelligent devices to retail packaging is well known within the art. References in the area of RFID tags and smartcards are further provided in the next section to that effect.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kourouthanassis P. and G. Roussos, "Developing Consumer Friendly Pervasive Retail Systems," IEEE Pervasive Computing, Vol.2, no 2, 2003, PP 32-39. Covers

aspects of intelligent retail concepts such as inclusion of intelligent tags (RFID) to track and validate product information.

- Fodor O., and V. Hassler, "Javacard and Opencard Framework: A Tutorial", 7th **IEEE** International Conference on, Volume 1, 1999, pp. 13 –22. Provides an overview of Smartcards, Java Card and Open Card Framework.
- Finkenzeller Klaus, "RFID Handbook", John Wiley & Son, 2003. Covers RFID technology, and its various applications and embodiments.

### **Contact**

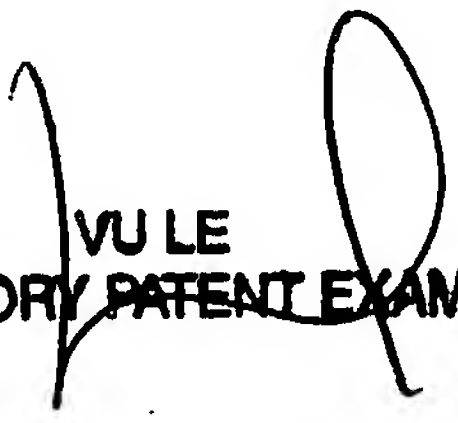
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Marandi whose telephone number is (571) 270-1843. The examiner can normally be reached on 8:00 AM- 5:00 PM M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James R. Marandi/

  
**VU LE**  
**SUPERVISORY PATENT EXAMINER**